Remarks

Claim Rejections – 35 USC § 101

Claims 60 and 62 have been amended to recite that the software is recorded on a computer-readable medium and it is submitted that this renders the claimed subject-matter statutory.

Claim Rejections – 35 USC § 102

Claim 35 stands rejected as anticipated by Beyda. It is submitted that at least the following features are neither known from nor suggested by Beyda:

(1) "presenting at least one of said users in the main conference with a graphical list of the main conference participants"

(2) "providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface," and

(3) "presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress".

Inherency

Before commenting in detail on each of these features, it is noted that the rejection as set out in the Office Action relies in large part on features (1) and (3) above being inherent, and on the supposed operation of such inherent features as regards feature (2).

Since any "inherently present" feature is by definition not explicitly disclosed in a reference, the MPEP sets out a certain standard for supporting such rejections at section 2112:

> IV. "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY"
>
> The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ..."To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized

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by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

1) Presenting a graphical list of main conference participants

The finding made in the Office Action that feature (1) above is known from Beyda, is based on the argument that "a list of users must inherently be presented to a user for them to determine an appropriate subconference participant."

From the MPEP, it is clear that such a determination can only be supported if the missing feature (presenting a list of main conference participants) must necessarily be present in Beyda's system, and if it would be so recognized by persons of ordinary skill. Probabilities and possibilities are not sufficient.

Presenting a graphical list of main conference participants is not **necessary** to initiate a sub-conference. Beyda clearly states that the terminals can be either telephones or computing devices with telephony capabilities. Clearly if the presentation of graphical lists of main conference participants was necessary for Beyda's system to work, telephones (which do not conventionally have the necessary graphical display capabilities) would not be appropriate.

It is well known that users can arrange telephone calls without having a graphical list of potential participants, simply by dialling telephone numbers or internal extension numbers or by hitting assigned speed-dial keys.

Similarly, to arrange a conference call, it is not required that the potential conference participants be presented as a graphical list from which they are selected to initiate the conference.

For the same reasons, when a conference is in progress, all that Beyda teaches is that a request is sent to the conference participants with whom a subconference is

desired. This could be done in many ways, including using the keypad to identify the participants' telephone number or extension number, or by selecting buttons assigned to the incoming lines for the individuals. There is no necessity that a graphical list be presented and thus the allegation of inherency cannot be justified.

2) Providing the user with an interface to allow selection of subconference participants from the graphical list

Regarding feature (2), claim 35 specifies *"providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface"*.

In relation to this feature reference is made in the Office Action to Figure 1 of Beyda, with the comment that "first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based on the inherently known list of participants".

It is not disputed that first terminal 14 of Beyda transmits such a subconference call request. However, the reasoning provided is entirely silent on where there is a disclosure, implicit or otherwise, of a user interface allowing selection from a graphical list. Simply because a user sends a request from one terminal to another does not mean that the user must have selected the other user from a graphical list using an interface designed for this purpose.

It is respectfully pointed out that all that is required for first terminal 14 to transmit a request to sixth terminal 24, is a valid network connection. The terminals do not need to know of one another's existence to transmit this request.

Furthermore, the claimed invention requires that the user can **interact** with a list of conference participants and can select members of this list for a subconference. Nothing in the material cited by the Examiner discloses, explicitly or inherently, such a capability.

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3) Presentation of a subconference list when the subconference is in progress

In relation to feature (3), the Examiner states that "the list of the subset of users in the subconference is inherently present during the subconference". It is not clear what this means – the list is inherently present where?

It is agreed that the subconference system must inherently maintain a record of the subconference terminals in order to achieve the appropriate audio signal mixing. This of course has no bearing on whether that information is ever displayed to anyone. Beyda never mentions or suggest displaying the information to any of the users.

To take a very close analogy, when one makes a telephone call using a cellphone, the cellular network "inherently knows" which cell a user is located in. It must know this for the system to work. This does not mean that that information is ever presented to the user, and in fact it is not. Thus, information which the subsystem of Beyda must know about is not in fact ever presented to the user, and the entire disclosure gives no reason at all to suppose that presentation of this information is desirable or necessary.

Conclusion

Beyda discloses only that a user sends a request to a terminal to begin a subconference. The reference is silent on how this is achieved. In contrast, the wording of claim 35 makes it very clear that a user must be able to initiate a subconference by employing an interface which displays a list of conference participants. After the subconference begins, that same user must be presented with a list of the actual subconference participants. Nothing in the Office Action bridges this rather large gap between what Beyda requires and what is in fact required by claim 35.

In summary, therefore, it is our submission that the disclosure of Beyda fails to provide any teaching, inherent or otherwise of at least the features of claim 35 identified above. As corresponding features are included throughout the independent claims, it is submitted that each of the independent claims, and each dependent claim, is patentable over Beyda at least for the reasons given above.

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Accordingly, it is submitted that the Application is in order for allowance, and further and favourable reconsideration is requested.

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Respectfully submitted,

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